

**TRANSMITTAL LETTER
(General - Patent Pending)**

Docket No.
09430001AA

In Re Application Of: **TC Cherng, et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/160,991	September 25, 1998	H. Payer	30743	3724	6990

Title: **CUTTING DIE AND METHOD OF FORMING**

COMMISSIONER FOR PATENTS:

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PETITION TO INVOKE THE SUPERVISORY AUTHORITY OF THE COMMISSIONER

in the above identified application.

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Signature

Dated: **August 14, 2006**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Tzyh-Chyang Cherng et al. Conf. No.: 6990
Serial No.: 09/160,991 Group Art Unit: 3724
Filed: September 25, 1998 Examiner: H. Payer

For: CUTTING DIE AND METHOD OF FORMING

Commissioner for Patents
United States Patent and Trademark Office
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PETITION TO INVOKE THE SUPERVISORY AUTHORITY
OF THE COMMISSIONER UNDER 37 C.F.R. §1.181(a)(3)
OR 37 C.F.R. §1.182
INCLUDING PETITION FOR WITHDRAWAL OF FINALITY OF OFFICE
ACTION UNDER 37 C.F.R. §1.181(a)(1)

Sir:

Applicants hereby respectfully petition the Commissioner to invoke the supervisory authority of the Commissioner under 37 C.F.R. §1.181(a)(3) or, alternatively, under 37 C.F.R. §182, as a question not otherwise specifically provided for, to provide additional supervision and oversight of the Examination of this application and, preferably, to assign the Examination of the above-identified application to a different Examiner and Supervisor. Additionally, Applicants hereby respectfully petition under 37 C.F.R. §1.181(a)(1) or as an incident of the consideration of this petition under 37 C.F.R. 1.181(a)(3) or §182 that the finality of the Office Action mailed June 6, 2006, be withdrawn.

STATEMENT OF FACTS

1. This application is a continuation and claims priority under 35 U.S.C. §120 of U. S. Patent Application 08/602,379, filed February 16, 1996, and thus has now been pending for more than ten years.

2. Since the filing of this continuation application on September 25, 1998, at least eleven office actions (in addition to Advisory Actions and the Examiner's Answer and Decision on Appeal) have issued on August 25, 1999, January 19, 2000, July 20, 2000, January 4, 2001, August 17 2001 (remailed November 6, 2001), March 7, 2001, July 16, 2002, December 17, 2004, September 1, 2005, December 2, 2005, and the present office action of June 6, 2006.

3. Close Supervisory review under the provisions of M.P.E.P. §707.02 was requested in the response filed June 17, 2005.

4. Several of the above-noted office actions contained procedural errors and irregularities. These errors and irregularities have resulted in unusual delays in the prosecution of the application or otherwise have failed to properly and timely consider this application.

For example, from the recent prosecution of this application, in the office action of September 1, 2005, following the response of June 17, 2005, in which close supervisory review was requested in accordance with M.P.E.P. §707.02, restriction was required between the remaining copied claims 13 - 16 and the remainder of the claims (amended following the Decision on Appeal) by another Examiner while Examiner Payer was unavailable. After an interview by telephone with the Examiner and his

supervisor, Mr. Shoap, regarding the inconsistency of such a requirement with the possibility of constructive election being held and which concluded with the assurance from Mr. Shoap that constructive election would not be held, a response was filed promptly on September 6, 2005. After a delay of nearly three months, a further action holding constructive election contrary to the election made *and contrary to the assurances given to the undersigned by the Examiner's Supervisor, Mr. Shoap*, was mailed December 2, 2005. That action contained additional errors outlined in the response filed March 2, 2005, showing both the requirement for restriction and the holding of constructive election to have been in error as was effectively acknowledged in the present office action of June 6, 2006, in which action was taken on all claims *but without any discussion of the application of prior art to the claims previously held to be withdrawn from consideration* other than a brief comment in regard to dependent claims 12 and 41. Thus, action on amendatory matter presented June 17, 2005, was delayed until June 6, 2006, due to actions of the Examiner which were improper and ultimately withdrawn even though close supervisory review in accordance with M.P.E.P. §707.02 had been requested in the response immediately prior to the requirement for restriction.

5. Following the withdrawal of the requirement for restriction and action on all claims, consideration of the amendatory language presented June 17, 2005, was not reflected in the statements of the rejection of claims 2, 5 - 9, 12, 25, 26, 31 and 38 - 44 first made in the office action of June 6, 2006, but only in response to submitted remarks and still failing to address the entirety of the amendatory language. Specifically, the

office action of June 6, 2006, clearly indicates that amendatory subject matter presented June 17, 2005, was not properly considered. Specifically, in reply to previously submitted remarks in regard to forming a puddle of melted die body material and applying the powdered blade material to the puddle (as distinct from applying the powdered material to the laser beam) and the Examiner's failure to make a *prima facie* demonstration of obviousness, the Examiner indicates disagreement but merely asserts that the Maybon reference teaches melting material to form a puddle while the Examiner indicates nothing further in Maybon regarding claim recitations of *applying powdered blade material to the puddle*.

6. The above example is similar to the delay occasioned by improper procedure following the presentation of claims copied from U. S. Patent 5,855,149 to Islam. Specifically, after holding the amendment presenting claims 13 - 19 for purposes of interference to be non-responsive (due to the informality of underlining of the new claims) in the office action of January 19, 2000, to which a response was promptly made on February 10, 2000, the Examiner then does not act on the application again until July 20, 2000, and in that action refuses to consider copied claims 13 - 19 even after they were properly presented in response to the holding of non-responsiveness of January 19, 2000, and holds them withdrawn from consideration pending allowance of other claims. The following office action of January 4, 2001, (signed by a Supervisory Primary Examiner *for the Examiner*) continued to hold claims 13 - 19 withdrawn from consideration without further comment. Claims 13 - 19 were finally acted upon in the office action of August 17, 2001, *over twenty months after presentation*, and

involving several significant lapses of time following responses notwithstanding that the application should be treated as "Special" under M.P.E.P. 708.01(E) and (F).

Further, the action of August 17, 2001, while signed by the Group Director but without specifically noting approval of the rejection of claims copied from a patent, was not signed by a Primary Examiner and apparently did not include a form PTO-326 thus failing to set a period for response since the identical action was issued again on November 6, 2001, (setting a one-month shortened Statutory Period for response) and signed by the Primary Examiner but not the Group Director. Thus, the first actions on copied claims 13 - 19 of August 17, 2001 and November 6, 2001, were both procedurally defective and the following final rejection of March 7, 2002, including a rejection of copied claims is not signed by the Group Director.

7. The office action of June 6, 2006, has been made final even though it contains the first and only action on the merits of claims newly presented June 17, 2005, and previously held withdrawn from consideration.

8. Following the response filed June 17, 2005, the next office action was mailed September 1, 2005. Following the response filed September 6, 2005, the next office action was mailed December 2, 2006, Following the response filed March 2, 2006, the present office action was mailed June 6, 2006. In each case, the following office action was mailed nearly three months subsequent to the preceding response notwithstanding the fact that this application should be considered "Special" under M.P.E.P. §708.01(I) since it has been pending much longer than five years.

REMARKS

In view of the foregoing facts, all of which may be verified the official record of this application, it is respectfully submitted that the Examiner has repeatedly prolonged the prosecution of this application, largely through failing to follow established procedures as enunciated in the M.P.E.P. The Examiner has taken sequences of improper actions such as withdrawing claims from consideration which were copied from a U. S. Patent and even delaying taking that action for over five months while the application should have been considered "Special" and requiring restriction followed by holding constructive election contrary to the election made in response to the requirement while constructive election, if considered to be proper, could have been held at the time of the original restriction requirement rather than precipitating a substantial delay of nearly one year in prosecution of the application. Supervision of the Examiner has clearly been inadequate in view of the number of formally incomplete and/or procedurally improper actions in the record and the failure of the Examiner to address salient, explicit recitations of the claims and to make a *prima facie* demonstration of the propriety of the grounds of rejection contained in the numerous office actions of record. Further, action by the Examiner has generally not been timely, even during periods, such as the present, when the application should be considered "Special". Lack of adequate supervision has been particularly apparent in regard to both of these deficiencies of the official actions since the request therefor pursuant to the requirements and official policy enunciated in the provisions of M.P.E.P. §707.02 which also provides for supervisory intervention to expedite

resolution of issues properly presented by the application, quite contrary to the nature of the office actions which have issued and which include a holding of constructive election and errors incident thereto (which was ultimately deemed improper and withdrawn) directly contrary to assurance given to the undersigned by the Examiner's Supervisor, Mr. Shoap.

In view of these clear and continuing deficiencies in the Examination of this application, it is respectfully submitted that the requested relief of providing increased supervision of this application during further prosecution, preferably by a different Examiner and supervisor, is well justified to assure:

1. that office actions are taken in a timely manner, particularly in view of its "Special" status due to the protracted prosecution of this application;

2. that all grounds of objection and rejection and all requirements made include a *prima facie* demonstration of their propriety; and

3. that all future office actions are complete, procedurally and formally correct and reasonably well-directed to the expeditious resolution of all issues presented by the application. In this regard, it is also believed well-justified that such additional supervision and oversight should be provided by an official of the USPTO above the supervisory authority of the present Supervisory Primary Examiner such as the Special Programs Examiner of the Examining Group or the Group Director. Accordingly, such action is respectfully requested.

It is also respectfully submitted that the additional relief of withdrawal of the finality of the present action is also well-justified since the present office action contains the first and only rejection of claims 38 and 44 and other claims depending therefrom

previously held withdrawn from consideration in the preceding non-final office action. Accordingly, such action is also respectfully requested.

It is also respectfully submitted that 37 C.F.R. §181 provides ample basis for the granting of the relief requested which does not otherwise appear to be available before the Examiner and that the above Statement of Facts clearly establishes appropriate circumstances for invoking the supervisory authority of the Commissioner. Additionally, it is respectfully submitted that the long duration of the continuing pattern of deficiencies in examination evident here amply justify the granting of the relief requested under the provisions of 37 C.F.R. §182. While no petition fee is required under 37 C.F.R. §181, should it be determined that the relief requested can only be granted under the provisions of 37 C.F.R. §182 and/or that this petition must be considered as separate petitions for the grant of increased supervision, transfer of the application to a different Examiner and supervisor and withdrawal of the finality of the present office action, please charge any required fees therefor and credit any overpayment to Attorney's Deposit Account 50-2041.

Respectfully submitted,



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